

REMARKS

Claims 1-24 are pending in the application. In the Office Action dated May 5, 2004, the Examiner objected to the Abstract and to Claims 23 and 24. Further, Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,442,806 ("Barber") in view of U.S. Pat. No. 5,832,367 ("Bamburak"). In this Amendment, Claims 1, 3, 6, 10, 12, 15, 17, 19, 23, and 24 have been amended. Applicants respectfully request reconsideration and withdrawal of the objection to the Abstract and to Claims 23 and 24, and the rejection of Claims 1-24 in light of the amendment to the claims and the following remarks.

I. Abstract and Claims 23 and 24

That Abstract has been provided on a separate page as requested by the Examiner. Additionally, Claims 23 and 24 have been amended as requested by the Examiner. Applicants requested withdrawal of the objection to the Abstract and to Claims 23 and 24.

II. The Proposed Combination of Barber and Bamburak does Not Render the Presently Claimed Invention Unpatentable

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Barber in view of Bamburak. Claims 1, 3, 6, 10, 12, 15, 17, 19, 23, and 24 have been amended to be directed towards a mobile station having a system access list ("SAL") wherein the mobile station identifies a current communication system servicing a geographic area where the mobile station is presently located ***independent of any frequency bands listed in the SAL stored in the mobile station***. Critically, at no time does the mobile station perform searches of frequency bands according to search schedules stored in the SAL of the mobile station.

The Examiner relies on Bamburak for providing an intelligent roaming method in which a frequency band search schedule stored on a SAL of a mobile station lists optimal frequency bands. The search schedules of Bamburak are fundamentally different from the frequency bands listed in the SAL of the presently claimed invention. In Bamburak, the mobile station searches for a current communication system

according to search schedules listed in a SAL stored in the mobile station, wherein a frequency band's position in the search schedule determines the priority of the frequency band. Critically, the search schedules of Bamburak limit the frequency bands searched by the mobile station. Thus, Bamburak can not provide any operations for a frequency band of a communication system that is not listed in the a search schedule of Bamburak.

In contrast to Bamburak, the presently claimed invention is not limited to frequency bands listed in a search schedule stored in the SAL due to the fact the mobile station identifies a current communication system ***independent of any frequency bands listed in a SAL stored in the mobile station.*** In the presently claimed invention, the frequency band of the current communication systems is simply compared to the frequency bands listed in the SAL. Each of the independent claims of the presently claimed invention recites this limitation.

The Examiner admits that Barber does not disclose predetermined frequency bands listed in a SAL. Therefore, due to the fact that Bamburak and Barber do not disclose a mobile station having a SAL that identifies a current communication system independent of any frequency bands listed in the SAL, the proposed combination of Bamburak and Barber necessarily cannot render the presently claimed invention unpatentable. Applicants request withdrawal to the rejection to Claims 1-24.

III. CONCLUSION

In view of the foregoing amendment and remarks, Applicants submit that the pending claims are in condition for allowance. Reconsideration is therefore respectfully requested. If there are any questions concerning this Response, the Examiner is asked to phone the undersigned attorney at (312) 321-4200.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Scott W. Brim", is written over a horizontal line.

Scott W. Brim
Registration No. 51,500
Attorney for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200